

Appl. No. 10/631,996
Reply to Examiner's Action dated September 8, 2005

REMARKS/ARGUMENTS

The Applicants have carefully considered this application in connection with the Examiner's Action and respectfully request reconsideration of this application in view of the following remarks.

The Applicants originally submitted Claims 1-18 in the application. Claims 6-18 were withdrawn pursuant to a restriction requirement. Claim 5 has been amended in the present response. Accordingly, Claims 1-5 are currently pending in the application.

I. Formal Matters and Objections

The Examiner has objected to Claim 5 because it depends on withdrawn Claim 6. The Applicants have amended Claim 5 herein to depend from Claim 1, and respectfully request that the Examiner withdraw the objection.

II. Rejection of Claims 1-5 under 35 U.S.C. § 103(a)

The Examiner has rejected Claims 1-5 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,986,811 to Wohlstadter. The Applicants respectfully traverse the Examiner's rejection, because Wohlstadter fails to teach or suggest each and every limitation of independent Claim 1.

The Examiner incorrectly asserts that Wohlstadter anticipates the element of Claim 1, "wherein the micro-lenses ... comprise hydrogel...." With respect to this limitation, the Examiner states in his response, "the office interprets the hydrophilic polymer to teach the claimed limitations."

Page 5, line 8. The portion of Wohlstadter cited by the Examiner in his assertion states:

Appl. No. 10/631,996

Reply to Examiner's Action dated September 8, 2005

3
E...

BEST AVAILABLE COPY

... transparent polymers have been used to make stable micro-lenses. For example, a solution of unpolymerized monomers (which are hydrophilic) will selectively adsorb to hydrophilic domains on a derivatized SAM surface. At that point, polymerization may be initiated (e.g., by heating). By varying the shape of the derivatized surface domains, the amount of solution on the domain, and the solution composition, a great variety of different lenses with different optical properties may be formed.

Col. 2, lines 55-63. This portion of Wohlstadter fails to teach hydrogel. Moreover, it does not teach the equivalent of hydrogel, because it does not teach that polymerization of hydrophilic monomers results in hydrogel. Even if the starting monomers are hydrophilic, this does not necessarily imply that the resulting polymer will be a hydrogel. Therefore, the Examiner's assertion that Wohlstadter anticipates the above-quoted element of Claim 1 is incorrect, and this passage fails to support the Examiner's *prima facie* case of obviousness of Claim 1 over Wohlstadter.

With respect to the limitation of Claim 1, "wherein the ... substrate comprise[s] hydrogel," the Examiner acknowledges that "Wohlstadter fails to explicitly teach the substrate is made of hydrogel." Page 5, line 11. The Examiner cites column 4, lines 7-8 for its teaching that [t]he cohesive and adhesive properties of liquid lens 52 can be adjusted by varying the chemistry of the liquid material, and by varying the chemistry of surface 54." The Examiner states that "the office interprets the use of the hydrophilic polymer to be included in the varied material." Page 5, lines 13-14. The Applicants respectfully disagree. But even if the cited passage were to teach that which the Examiner asserts, such a teaching would not teach a hydrogel. Indeed, this cited portion utterly fails to suggest hydrogel. It is well-established, that a *prima facie* case of obvious must include a prior art teaching for each element of the invention. Since the Office Action has not cited prior art for the

Appl. No. 10/631,996

Reply to Examiner's Action dated September 8, 2005

BEST AVAILABLE COPY

hydrogel feature, the Office Action's application of Wohlstadter does not establish a *prima facie* case of obviousness of Claim 1.

Due to the absence of a case of *prima facie* obviousness of Claim 1, claims 1-5 are allowable. Accordingly, the Applicants respectfully request that the Examiner withdraw the rejection of Claims 1-5 under 35 U.S.C § 103(a) and allow issuance thereof.

III. Conclusion

In view of the foregoing amendments and remarks, the Applicants now see all of the claims currently pending in this application to be in condition for allowance and therefore earnestly solicit a Notice of Allowance for Claims 1-5.

The Applicants request the Examiner to telephone the undersigned attorney of record at (972) 480-8800 if such would further or expedite the prosecution of the present application.

Respectfully submitted,

HITT GAINES, P.C.



David H. Hitt

Registration No. 33,182

Dated: December 2, 2005

P.O. Box 832570
Richardson, Texas 75083
(972) 480-8800